

REMARKS

This Preliminary Amendment is responsive to the March 16, 2004, final Office Action, in which Claims 1-17 and 20-27 were pending of which Claims 1, 4-8, 11, 12, and 15-17, and 20-22 were rejected, Claims 2, 3, 13, and 14 objected to, and Claims 9 and 10 indicated as allowable. Claims 1 and 11 have been amended to make explicit what was always implicit in the claims and, thus, do not narrow the claims.

Claim Rejections – 35 U.S.C. §103

Claims 1, 4-8, 11, 12, and 15-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seaburn (6,084,662) (“Seaburn”). Applicant requests reconsideration.

The Examiner believes that “[t]he claim is written in an alternative form and thus the claim limitations are met if at least one of the alternatives is taught by the prior art.”

Applicant respectfully disagrees.

Independent Claim 1 is written in means plus function format under 35 U.S.C. §112, paragraph 6. Only one function was recited in originally filed Claim 1, namely “positioning a sample held on said sample support, said reflective element, or both said sample held on said sample support and said reflective element within a collection range”. Thus, there is a single function, which is positioning the sample, the reflective element or both within a collection range” and not alternative functions. Accordingly, Applicant submits that the claim was not written in an alternative form.

Nevertheless, Claim 1 has been amended to recite “means for positioning each of a sample held on said sample support, said reflective element, or both said sample held on said sample support and said reflective element within a collection range at least one of a sample held on said sample support and said reflective element within a collection range” so that it is clear to the Examiner that the Claim 1 recites a single function. Accordingly, the amendment to Claim 1 merely makes explicit what was always included in Claim 1, i.e., that there is a single function, and does not narrow Claim 1.

Additionally, the Examiner stated that the “the means for positioning is overcome by manually placing the sample support, reflective element or both within a collection range...” Applicant respectfully submits that the Examiner is not examining the claim properly under 35 U.S.C. §112, sixth paragraph.

Pursuant to USPTO and Federal Circuit guidelines for the examination of 35 U.S.C. §112, sixth paragraph, the scope of “means or step plus function” limitations must be given

the “broadest reasonable interpretation” “in light of and consistent with the written description of the invention in the application.” MPEP §2181, discussing In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d. 1845 (Fed. Cir. 1994). “[T]he PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” Id. As discussed in the MPEP §2182, “under Donaldson an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.”

Applicant submits that the Examiner has not met this initial burden of proof for showing that “manually placing the sample support, reflective element or both within a collection range” is the same or equivalent structure described in the specification. Consequently, for at least these reasons, Claim 1 is patentable over Seaburn.

Claims 4-8 and 23 depend from Claim 1 and are therefore patentable for at least the same reasons as Claim 1.

With regard to independent Claim 11, the Examiner took Official Notice “that the use of optical elements such as lenses and apertures to change the position of light beams are old and well known in the art.” Applicant submits that relying on this Official Notice to reject Claim 11 is inappropriate.

Claim 11 does not recite simply using an optical element to change the position of a light beam, which is what the Examiner is taking Official Notice. Claim 11 recites much more than that. Claim 11 recites “at least one of said lens elements and said aperture stop are adjusted to alter a collection range to selectively position a sample held on said sample support, said reflective element, or both said sample held on said sample support and said reflective element within said collection range”. Applicant submits that the Examiner’s Official Notice of “the use of optical elements such as lenses and apertures to change the position of light beams” can not fairly be expanded to cover Claim 11.

Claim 11 has been amended to recite “selectively” again to make it clear to the Examiner that each of the three positions are possible, i.e., the sample, the reflective element or both are positioned in the collection range. Thus, the amendment to Claim 11 merely makes explicit what was always implicit and therefore does not narrow Claim 11.

Accordingly, for at least those reasons, Claim 11 is patentable over Seaburn. Claim 26 depends from Claim 11 and are therefore patentable for at least the same reasons as Claim 11.

Independent Claim 12 recites “selectively configuring a collection range to include said sample, said reflective element or both said sample and said reflective element”. Claim 12 does not include an alternative limitation, because the element states “selectively configuring a collection range to include” In order to give meaning to the word “selectively” more than one possibility must exist. Seaburn does not teach or suggest selectively configuring a collection range to include the sample, the reflective element or both. Accordingly, for at least those reasons, Claim 12 is patentable over Seaburn. Claims 13-22 and 27 depend from Claim 12 and are patentable for at least the same reasons.

Applicants submit that Claims 24 and 25, which depend from Claim 9 should be allowed for at least the same reasons that Claim 9 was allowed.

Claims 1-17 and 20-27 pending of which Claims 1 and 11 have been amended. For the above reasons, Applicants respectfully request allowance of Claims 1-17 and 20-27. Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 982-8202.

**Via Express Mail Label No.
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Respectfully submitted,



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